

I. REMARKS

Claims 24-28 are in the case. In the Amendments to the Claims in Section III (see below), Claims 24-28 have been cancelled and replaced with new Claims 29-40. Please note that the newly presented claims incorporate subject matter having a scope similar to corresponding apparatus claims previously allowed in the instant application's parent case (though in method form herein), testing method steps previously recited in independent Claim 24, and additional subject matter depending from combinations of these elements.

IV. AMENDMENTS TO THE DRAWINGS

The drawings stand objected to under 37 C.F.R. § 1.83(a) as failing to include every element present in the claims, and as failing to include several reference numerals included in the description of the invention presented in the specification. In response, Applicants have attached two (2) sheets of drawings, comprising (i) a Replacement Sheet, and (ii) an Annotated Sheet amended in accord with the Examiner's suggestions, which Applicants believe overcomes the instant objection.

V. TRAVERSAL OF REJECTIONS UNDER 35 U.S.C. § 112

Claims 25, 27 and 28 stand rejected under 35 U.S.C. § 112 on procedural grounds. As mentioned in the Remarks in Section II, each of prior Claims 24-28 has been cancelled and replaced with new Claims 29-40. The newly presented claims incorporate subject matter similar in scope to corresponding apparatus claims previously allowed in the instant application's parent case (though in method form herein), the testing method steps previously recited in independent Claim 24, and additional subject matter depending from combinations of these elements. Since each of Claims 29-40 complies with all of the requirements of 35 U.S.C. § 112, Applicants submit the pending rejection is obviated and should now be withdrawn. Reconsideration and withdrawal of the rejection on the above grounds is respectfully requested.

VI. TRAVERSAL OF REJECTIONS UNDER 35 U.S.C. § 103(a)

A. Claims 24-27 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,665,898 to Smith *et al.* in view of U.S. Patent No. 6,155,282 to Zachary. The rejection is respectfully traversed.

B. Procedurally, each of Claims 24-27 has been cancelled by amendment above, and replaced with new Claims 29-40. The newly presented claims incorporate subject matter similar in scope to corresponding apparatus claims previously allowed in the instant application's parent case (though in method form herein), the testing method steps previously recited in independent Claim 24, and additional subject matter depending from combinations of these elements. With regard to the scope of the newly presented claims *vis-à-vis* the prospect of additional examination being required, Applicants argue that since the totality of the subject matter added to the testing steps previously recited in independent Claim 24 is of roughly the same scope as the claims already allowed in the application's parent case, additional search time and further Office Actions are not believed necessary in the instant case despite the presence of a number of newly presented claims after issuance of an Office Action.

C. To establish a *prima facie* case of obviousness in view of a reference, the Office must meet three basic criteria. First, there must be some teaching, suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of successfully achieving the claimed invention if the references were actually combined as proposed. *Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and

not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991) (emphasis supplied); see also M.P.E.P. §§ 2143-2143.03.

D. As to the third prong of the *Vaeck* test (see italicized sentence immediately above), nowhere do the cited references, whether considered alone or in combination, teach or suggest a method of testing a variable function voting solenoid-operated valve, wherein the method comprises disposing a logic control system in electronic communication with each of said first solenoid-operated valve and said second solenoid-operated valve, and in electronic communication with each of said first pressure sensor, said second pressure sensor, and said third pressure sensor, and selectively activating one of either a 1-out-of-1 with hot stand-by testing mode and a 2-out-of-2 with high diagnostics testing mode as recited in independent Claim 29.

E. Applicants' position regarding the inadequacy of combining the Smith and Zachary references against the claims presented herein was implicitly affirmed in the prosecution record of the instant application's parent case (prior application no. 09/756,844, now issued as U.S. Patent No. 6,722,383). In particular, in an Action dated December 18, 2003, the Office considered the same Smith and Zachary references cited herein against independent apparatus claims having a scope similar to the instant method claims, and concluded that, even in combination, the references fail to teach or suggest each and every required claim element, especially with respect to recitation of a logic control system, and the capacity to selectively enable activation of either of two discrete operating modes, viz., a 1-out-of-1 with hot stand-by testing mode and a 2-out-of-2 with high diagnostics testing mode (see parent case Office Action at paragraph 24, a copy of which is enclosed for convenience). Accordingly, Applicants submit the newly presented method claims are also distinct over the references under the same rationale, and should be entered into the record and allowed in response to the instant Office Action.

Reconsideration and withdrawal of the rejections, and allowance of the claims at an early date, are respectfully requested.

VII. CONCLUSION

In view of the foregoing, Applicants submit that each ground of rejection pending in the case has been overcome, and the application is now in condition for allowance. Entry of the foregoing amendments, reconsideration and withdrawal of the pending rejections, and allowance of the case at an early date are respectfully requested.

Respectfully submitted,

Date: SEPTEMBER 15, 2004

By: Ray Ferrera

Raymond R. Ferrera, Esq.
USPTO Reg. No. 47,559
ARNOLD & FERRERA, L.L.P.
2401 Fountainview, Suite 630
Houston, Texas 77057
Tel. (713) 972-1150
Fax (713) 972-1180
ATTORNEY FOR APPLICANT